THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES C. ASHBY and ROY G. TIEMANN

Appeal No. 96-0308
Application 07/854,192[1]

ON BRIEF

Before MARTIN, FLEMING, and CARMICHAEL, *Administrative Patent Judges*.

CARMICHAEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 1-22, which constitute all the claims remaining in the application.

We affirm in part.

[1] Application for patent filed March 20, 1992.

Appellants' Claim 1 is reproduced as follows:

> 1. An instructional apparatus, comprising:
>
> a label adapted for being releasibly secured to a product; and
>
> means for repetitively and reusably recording a vocal message into said label indicative of an identifiable characteristic associated with said product.

The Examiner's Answer lists the following prior art:

Dittakavi	4,602,152	Jul. 22, 1986
Kondo	4,791,741	Dec. 20, 1988
Tarlow et al.(PCT application)	WO 88/10489	Dec. 29, 1988

OPINION

This appeal involves three separate rejections applicable respectively to Claims 1-18, Claims 19-21, and Claim 22. The three rejections are addressed separately below.

Claims 1-18

Claims 1-18 stand rejected under 35 U.S.C. § 103 as unpatentable over Tarlow in view of Kondo. Claims 2-14 stand or fall with Claim 1 and Claims 16-18 stand or fall with Claim 15. Appeal Brief at 6, lines 3-5.

The Examiner finds that Tarlow teaches the invention recited in Claims 1 and 15 except for the means for repeatedly and

reusably recording a vocal message. According to the Examiner, it would have been obvious to replace Tarlow's recording means with Kondo's reusable recording means because Kondo teaches that storing vocal messages in a random access memory (RAM) allows for greater versatility. Examiner's Answer at 3. This is the same means (a RAM) disclosed in Appellants' specification.

Appellants contend that the substitution would not have been obvious because it would destroy the intent and purpose of Tarlow. Appeal Brief at 13.

We agree with the examiner.

Tarlow discloses a voice recording and playback module system in which a user goes to a recording center and records a message on a playback module for insertion into a product. The recording center may be a booth in a store, for example. Page 2, lines 17-30; page 6, lines 1-7. Tarlow's system operates as follows.

First, a user temporarily records a message in a RAM at Tarlow's recording center. Second, the user plays back the message from the RAM. Third, if the user wishes to change the message, the user re-records until satisfied with the message. Page 2, line 30 through page 3, line 10; page 4, lines 3-12; and page 7, lines 13-23.

Fourth, once satisfied with the message the user in Tarlow's recording center pushes a "transfer" button. Fifth, upon receiving the transfer command the recording center transfers the message from its RAM by permanently "burning" the message into an electronically programmable read only memory (EPROM) contained in a removable playback module. Sixth, the user inserts the playback module into a compartment within a greeting card or other product. Page 3, line 8 through page 4, line 2; page 4, lines 13-19; and page 7, line 24 through page 8, line 27.

Thus, Tarlow repetitively records a message in a recording center's RAM and then permanently transfers a recorded message from the RAM to a playback module's EPROM. The playback module constitutes the recited "label adapted for being releasibly secured to a product." Tarlow's recording center is a means for repetitively and reusably recording a vocal message in a RAM and for reusably recording the message into the playback module's EPROM.

Tarlow's recording center does not repetitively and reusably record a message into the playback module/label (Claim 1) and does not sequentially and reusably store a signal in RAM contained in the label (Claim 15). Rather, Tarlow intends the playback module's EPROM to store a message permanently. Page 2,

lines 14-16 and lines 23-27; page 3, lines 22-25; and page 10, lines 22-25.

Kondo points out that greeting cards with read only memories have limited usefulness and convenience. Instead, Kondo suggests using a reusable RAM memory in a greeting card such that the user can replace a message in RAM with a new message. Kondo suggests including the record and playback devices both in the same card so that the user can easily record and play back a message. Kondo identifies as an advantage that the card can be widely used for a variety of occasions. Column 1, lines 17-28; and column 4, lines 12-31.

Kondo's suggestion to replace a greeting card's permanent read only memory with a reusable RAM would have led one of ordinary skill in the art to replace the read only memory in Tarlow's greeting card with a RAM. It would have been obvious to include a RAM recording and playback means in Tarlow's greeting card so that a user could easily record and play back a message as taught by Kondo.

Kondo describes prior greeting cards with prerecorded messages in which the user could not record an individual message. Kondo at column 1, lines 17-20. Tarlow requires a user to come to a recording center to record an individual message.

Kondo's suggestion to include a RAM recording and playback means in a greeting card so that a user can easily record a message is applicable to Tarlow's greeting card. From the collective teachings of Kondo and Tarlow one skilled in the art would have recognized as an advantage that a user would not have to come to a recording center if a RAM recording and playback means were included in Tarlow's greeting card.

As Appellants point out, Tarlow desires to permanently preserve a vocal message. Tarlow states that "[t]he recording would have to be of a permanent nature in order to preserve the quality and fidelity of a dear relative's voice." Page 2, lines 14-16. Nonetheless, Kondo taught advantages to recording a greeting card message in a temporary memory (a RAM) instead of a permanent memory. When the collective teachings of the cited art are viewed as whole, they suggest the claimed subject matter.

Thus, we will sustain this rejection.

Claims 19-21

Claims 19-21 stand rejected under 35 U.S.C. § 103 as unpatentable over Kondo in view of Tarlow.

The examiner finds that Kondo teaches the claimed invention except for releasibly securing Kondo's card to products, and that Tarlow teaches releasibly attaching a playback module to a

variety of products. According to the examiner, it would have been obvious to use Kondo's card on a variety of products. Examiner's Answer at 4.

Appellants argue that using Kondo's card on a variety of products does not equate to a reusable, recordable product label. Appeal Brief at 19, lines 9-10.

We agree with Appellants.

Claim 19 recites a number of steps relating to reusing a recordable product label. In the first four steps, a label bearing a recorder is secured to a first product, a message concerning the first product is recorded in the label, and the message is played. In the fifth step, the label is released from the first product and attached to a second product. In the sixth and seventh steps, the first message is erased and a message regarding the second product is recorded. In the eighth step, the second message is played.

Tarlow teaches securing a playback module to a variety of products. Page 3, line 33, through page 4, line 2. However, Kondo wires a recordable label into each greeting card, so there is no need to reuse the label in a different card. The examiner identifies no rationale for removing Kondo's label from one card

and reusing it for another one. Lacking such a rationale in the prior art, we will not sustain this rejection.

Claim 22

Claim 22 stands rejected under 35 U.S.C. § 102 as anticipated by Dittakavi.

Claim 22 calls for (1) a bar code label; (2) a voice recorder capable of recording a vocal message as voice input into a storage device corresponding to the bar code label; and (3) retrieving means capable of reproducibly retrieving the message and operable to reproduce and vocalize the recorded vocal message.

Dittakavi discloses a synthetic speech system that decodes an input bar code and consults a look up table to retrieve frames of associated digital information. Dittakavi's look up table contains synthetic speech codes such as allophones that may each correspond to one letter of the alphabet. The frames are fed to a synthesizer which creates audible material from the digital information. Column 3, lines 6-36. For example, Figure 1 shows a book that has bar codes under the written text. The synthesizing apparatus reads the bar codes and synthesizes the sounds of each word in the text.

According to the examiner, Dittakavi inherently contains the recited recording means in that his bar code represents speech. Final Rejection (Paper No. 13) at 6, lines 14-20. We disagree.

Dittakavi's apparatus does not inherently include a voice recorder capable of recording a vocal message as voice input. Dittakavi's apparatus has no need for vocal input because the voice of the message sender is not reproduced. All that Dittakavi needs to create synthetic speech output is written bar codes representing allophones. The code is not specific to a particular voice. There is no teaching of or reason for creating Dittakavi's written code from voice input as opposed to creating it from written input.

Dittakavi's speech synthesizer may contain a prerecorded sound for each letter of the alphabet. However, such a prerecorded sound is not a vocal message recorded by the instructional apparatus as voice input.

Thus, we do not sustain the rejection of Claim 22.

CONCLUSION

The rejection of Claims 1-18 is sustained. The rejection of Claims 19-21 is not sustained. The rejection of Claim 22 is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED IN PART

JOHN C. MARTIN Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT)) APPEALS AND)) INTERFERENCES
JAMES T. CARMICHAEL Administrative Patent Judge	)

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